#11 1637
7/8/03

Docket No. CDS-232

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John W. Sutherland

Serial No. : 09/877,748 Art Unit: 1637

Filed : June 11, 2001 Examiner: Cynthia Wilder

For : DETECTING NUCLEIC ACID DETECION SEQUENCES

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 On:

July 1, 2003

(Date)

Todd F. Volyn

Name of applicant, assignee, or Registered Representative

Todd Volyn

(Signature)

July 1, 2003

(Date of Signature)

Commissioner for Patents
PO Box 1450
Alexandria, VA 226313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

This communication is responsive to the Office Action dated June 10, 2003 that relates to the application noted above.

The Examiner has levied a restriction requirement that divides the application into three potential groups. She has further restricted the last group (Group III) into different inventions for each recited species of nucleic acid recited in the claims.

Applicant elects Group I with traverse.

Group I inventions are directed to methods for detecting nucleic acid mutations (e.g., deletions). Group II inventions are directed to methods for quantitating nucleic acids having deletions. The Examiner maintains these two groups of inventions are unrelated and that they have different modes of operation, different functions, or different effects. One cannot quantitate a nucleic acid with a deletion without detecting it. Indeed, quantitation, in this context, is detection with numerical specificity and deletions are mutations. Accordingly, it cannot be fairly said that Group I and Group II claims are drawn to unrelated processes such that restriction is required.

With respect to the sequences recited in Group III, the Examiner is respectfully reminded that it is the position of the PTO that:

> "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et.seq.*, and permit a reasonable number of such nucleotide sequences in a single application." MPEP 803.04

Ordinarily, the PTO considers at least ten sequences to be a reasonable number. In this case, the recited sequences are primers and probes (two primers and one probe per target). Thus, the total of 22 claimed short sequences are well within the guidelines set by the Commissioner. In any case, including all of the claimed inventions together does not pose a serious burden on the Examiner since searching within any of the fields of the various Groups of inventions will require a search of every field among the three Groups anyway.

The restriction requirement should be removed entirely. Even if this does not occur, Group I and Group II inventions should be prosecuted together. The Examiner is thus respectfully solicited to take such action.

Please charge any fees which may be required for this submission to Johnson & Johnson Deposit Account No. 10-0750/CDS-232/TFV.

Respectfully submitted,

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Dated: July 1, 2003